

REMARKS

Claims 1-20 are currently pending in the application. In view of the remarks that follow, Applicants respectfully request reconsideration.

Independent Claim 1

Independent Claim 1 stands rejected under 35 USC §103 as obvious in view of newly-cited Szekeresch U.S. Patent No. 6,919,538. This ground of rejection is respectfully traversed. In this regard, the PTO recognizes in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that Szekeresch fails to establish a *prima facie* case of obviousness under §103 with respect to Claim 1, for the mutually exclusive reasons that are discussed below.

THE REJECTION FAILS TO COMPLY WITH PTO REQUIREMENTS

MPEP §706.02(j) explains that an examiner must satisfy four specific requirements in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103. In particular, MPEP §706.02(j) specifies that:

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under

35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon,
preferably with reference to the relevant column or page number(s)
and line number(s) where appropriate,

(B) the difference or differences in the claim over the
applied reference(s),

(C) the proposed modification of the applied reference(s)
necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at
the time the invention was made would have been motivated to
make the proposed modification.

In the present situation, the §103 rejection of Claim 1 fails to satisfy two of these four requirements, for reasons that are discussed separately below.

In more detail, the paragraph bridging pages 2-3 of the Office Action identifies portions of Szekeresch that are believed to be relevant to Claim 1. This satisfies the first of the four requirements above (requirement A). Further, this paragraph identifies a difference between Szekeresch and the subject matter of Claim 1, and therefore satisfies requirement (B). In particular, the Office Action indicates that, although Szekeresch discloses a subsystem having a heating element 10, "Szekeresch et al does not disclose a compensation heating element to alter the process chamber temperature profile".

However, the explanation of the rejection fails to satisfy requirement (C). In particular, after admitting that "Szekeresch et al does not disclose a compensation heating element to alter the process chamber temperature profile", the Office Action does not propose any structural modification to Szekeresch that would include the addition of a compensation heating element and thus yield a configuration equivalent to the subject matter of independent Claim 1. Consequently, the §103 rejection fails to satisfy PTO requirement (C).

In addition, since the Office Action does not propose any modification to Szekeresch, the Office Action does not discuss why a person of ordinary skill in the art would be motivated to make any modification to Szekeresch. Accordingly, the §103 rejection fails to satisfy PTO requirement (D).

Applicants therefore respectfully submit that the §103 rejection is defective, because it fails to satisfy two of the PTO's four specific requirements for a proper §103 rejection. In particular, the Examiner has not identified (1) how Szekeresch would need to be modified in order to meet Claim 1, or (2) why a person skilled in the art would be motivated to make the proposed modification. Applicants are not required to engage in guesswork where, as here, the Examiner fails to provide all of the information that the PTO requires in every §103 rejection, and thus fails to establish a *prima facie* case of obviousness. Instead, as pointed out in MPEP §2142, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness". For this reason alone, it is respectfully submitted that the pending §103 rejection of Claim 1 is defective and must be withdrawn, and notice to that effect is respectfully requested.

THE PRIOR ART MUST TEACH ALL CLAIM LIMITATIONS UNDER §103

The MPEP repeatedly emphasizes the requirement that, in order to establish a *prima facie* case of obviousness under §103, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added). The PTO considers this requirement to be important, as evidenced by the fact that this exact language appears at a number of different locations in the MPEP, for example in each of MPEP §706.02(j), MPEP §2142, and MPEP §2143. In the present application, the §103 rejection is based solely on Szekeresch. As discussed above, the Office Action admits that "Szekeresch et al does not disclose a compensation heating element to alter the process chamber temperature profile". As also discussed above, the Office Action does not propose any modification to Szekeresch that

would cure this deficiency. The Office Action asserts on page 3 that the heating element 10 disclosed in Szekeresch:

is capable of performing the same function [as] . . . a
compensation heating element. In Szekeresch et al, each
heating element compensates for itself.

However, Applicants' Claim 1 expressly recites two separate and distinct heating elements. In order to meet the subject matter of Claim 1, the prior art underlying the §103 rejection must disclose all of the limitations in Claim 1, including two distinct heating elements. Here, the Office Action expressly admits that Szekeresch does not disclose one of the two different heating elements that are expressly recited in Claim 1, and then leaves it at that. Since the §103 rejection is based solely on Szekeresch, and since the Office Action admits that Szekeresch does not disclose one of the heating elements recited in Claim 1, the §103 rejection necessarily fails to establish that the prior art underlying the rejection discloses all of the limitations of Claim 1. The rejection therefore fails to satisfy the requirements of MPEP §§706.02(j), §2142, and §2143, and in particular fails to establish a prima facie case of obviousness. Consequently, for this independent reason alone, it is respectfully submitted that Claim 1 is not obvious under §103 in view of Szekeresch, and notice to that effect is respectfully requested.

NO MOTIVATION IS GIVEN FOR ANY MODIFICATION OF SZEKERESCH

Even assuming that the foregoing arguments do not apply (which is clearly not the case), there is yet another reason why the proposed §103 rejection is defective. In this regard, MPEP §2142 provides that:

To reach a proper determination under §103, the examiner must
step backward in time and into the shoes worn by the hypothetical

"person of ordinary skill in the art" when the invention was unknown and just before it was made. . . . Knowledge of applicant's disclosure must be put aside in reaching this determination, . . . impermissible hindsight must be avoided, and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In addition, MPEP §2143.01 provides at that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. . . . Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". (Emphasis in original).

As discussed above, the Office Action not only fails to mention any modification of Szekeresch that would be needed in order to meet the subject matter of Claim 1, but also fails to offer any motivation for making such a modification. The present §103 rejection of Claim 1 is therefore incomplete, because it fails to demonstrate the motivation that is specifically required by the MPEP. Accordingly, for this independent reason alone, it is respectfully submitted that Claim 1 is not rendered obvious under §103 by Szekeresch, and notice to that effect is respectfully requested.

In view of the foregoing discussion, it is respectfully submitted that the Office Action fails to establish a prima facie case of obviousness with respect to Claim 1, for several independent reasons that are discussed separately above. It is therefore respectfully submitted

that Claim 1 is not rendered obvious under §103 by Szekeresch. Accordingly, Claim 1 is believed to be allowable, and notice to that effect is respectfully requested.

Independent Claims 16 and 17

Independent Claim 16 includes limitations that recite:

- a temperature sensor configured to detect the process chamber temperature profile;
- a mechanism to determine variation between the process chamber temperature profile and a desired temperature profile; and
- a compensation heating element configured to alter the process chamber temperature profile in response to the variation detected by the mechanism.

Independent Claim 17 includes limitations that recite:

- detecting the process chamber temperature profile;
- determining a variation between the process chamber temperature profile and the desired temperature profile for the process chamber; and
- adjusting power delivered to a compensation heating element based on the variation.

Independent Claims 16 and 17 each stand rejected under 35 USC §103 as obvious in view of Szekeresch. The explanation given in the Office Action is exactly the same explanation given for the §103 rejection of Claim 1. The rejections of Claims 16 and 17 are both respectfully traversed. More specifically, for reasons similar to those discussed above in association with

Claim 1, it is respectfully submitted that the Office Action fails to establish a prima facie case of obviousness with respect to either of Claims 16 and 17, and that Claims 16 and 17 are therefore not rendered obvious under §103 by Szekeresch. Consequently, Claims 16 and 17 are believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-15 and Claims 18-20 respectively depend from Claim 1 and Claim 17, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 1 and 17.

Conclusion

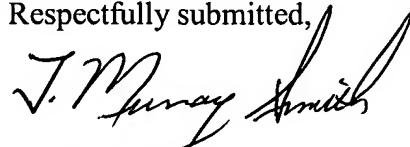
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Appl. No. 10/753,253
Reply to Office Action of July 28, 2005

Attorney Docket No. 2003-0440 / 24061.081
Customer No. 42717

Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: Petition for Time Extension (One-Month)
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